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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/046,294      | 01/16/2002  | Brian Graham Taylor  | 12359               | 2323             |

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EXAMINER

BOCHNA, DAVID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/046,294

Applicant(s)

TAYLOR, BRIAN GRAHAM

Examiner

David E. Bochna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8,10-22 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,10-17, 19-22,25-29 and 32-38 is/are rejected.
- 7) ☒ Claim(s) 18,30,31,39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, 10-17, 19-22 and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al.

In regard to claim 1, Smith et al. (fig. 1) discloses a riser connector (“for connecting first and second tubulars 12 of an offshore riser for transporting fluids between a well-head at the seabed and the surface” is intended use language and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)); the connector comprising a first portion on the first tubular, the first portion having first 24 and second 74 axially extending portions and a threaded portion 22 positioned therebetween, the first axially extending portion 24 being located between the threaded portion and the terminus of the first tubular; and a second portion on the second tubular, the second portion having first 48 and second 66 axially extending portions and a threaded portion 38 positioned

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therebetween, the first axially 48 extending portion being located between the threaded portion and the terminus of the second tubular;

wherein the second axially extending portion 74 of the first portion and the first axially extending portion 48 of the second portion are greater in length than the first axially extending portion 24 of the first portion and the second axially extending portion 66 of the second portion; and wherein, in the assembled connector are mutually parallel.

In regard to claim 8, a spigot 32, 48 and a socket 74, 66 comprise the axially extending portions on each tubular.

In regard to claim 10, the spigot 32 on the first tubular 14 engages the socket 66 on the second tubular 12.

In regard to claim 11, the spigot 48 on the second tubular 12 engages the socket 74 on the first tubular.

In regard to claim 12, the first tubular 14 comprises a pin connector.

In regard to claim 13, the second tubular 12 comprises a box connector.

In regard to claim 14, the socket 74 of the first tubular and spigot 48 on the second tubular 12 are greater in length than the socket 66 of the second tubular and spigot 32 of the first tubular.

In regard to claim 15, the axially extending portions are parallel to the axis of the tubulars.

In regard to claim 16, the first and second tubulars have a tapered profile 22, 38.

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In regard to claim 17, the tapered portions of the first and second tubulars are the threaded portions 22, 38 of the first and second tubulars and have co-operating tapers to facilitate mating of the two portions.

In regard to claim 19, the first and second portions have mutually engaging threaded portions 22, 38.

In regard to claim 20, the axially extending portions 74, 24, 44, 66 are unthreaded.

In regard to claim 21, the axially extending portions are load-bearing and allow the transfer of loads between the tubulars.

In regard to claim 22, the axially extending portions allow the transfer of bending loads between the tubulars.

In regard to claim 32, wherein, during assembly of the connector, the second axially extending portion of the first portion and the first axially extending portion of the second portion are engaged before the first axially extending portion of the first portion and the second axially extending portion of the second portion are engaged.

In regard to claim 33, wherein, during assembly of the connector, the second axially extending portion of the first portion and the first axially extending portion of the second portion are engaged before the respective threaded portions are engaged.

In regard to claim 34, wherein, during assembly of the connector, the first axially extending portion of the first portion and the second axially extending portion of the second portion are engaged before the respective threaded portions are engaged.

In regard to claim 35, further comprising at least one seal (contacting surfaces 42 and 18).

In regard to claim 36, wherein two seals are provided (42 and 18 and 26 and 40).

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In regard to claim 37, wherein a first seal is adapted to prevent fluid being released from inside the connector to the threaded and axially extending portions of the connector.

In regard to claim 38, wherein a second seal is adapted to prevent ingress of fluid from outside the connector to the threaded and axially extending portions of the connector.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. '212. Smith et al. discloses a riser connector as described above, but does not specifically disclose the exact lengths recited in the present invention. However, it would have been obvious to a person having ordinary skill in the art to make the lengths that of those recited in claims 25-29 because a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

***Allowable Subject Matter***

3. Claims 18, 30-31 and 39-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. Applicant's arguments filed on 7/12/04 have been fully considered but they are not persuasive. Applicant argues that Smith et al. does not disclose a "riser", but rather a downhole

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tool and that a riser is a pipe line that extends from a seabed to the surface. Three references have been provided, Toon, Bond and Jones, which use the term "riser" when describing a pipe that is used in a downhole tool, and not underwater. This demonstrates that the term "riser" can be used to describe vertical drill pipes used in the oilfield drilling industry. In addition, the Merriam Webster's Collegiate Dictionary, 10<sup>th</sup> edition defines riser as "a vertical pipe (as for water or gas)...". Because Smith et al. discloses a coupling for a downhole pipe running vertically into the ground, the Smith et al. prior art rejection has been maintained.

Applicant also argues that the coupling of Smith et al. is made to handle high torsion loads and not high bending loads, such as the present invention. However, the focus of Smith et al.'s invention is irrelevant, as Smith et al. discloses all of the structural limitations recited by the Applicant.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toon, Bonds and Jones all disclose similar riser couplings common in the art.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

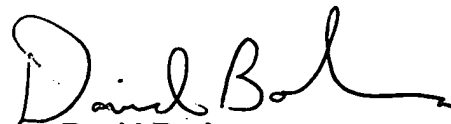
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

A handwritten signature in black ink, appearing to read "David Bochna", with a stylized flourish at the end.

**David Bochna**  
**Primary Examiner**  
**Art Unit 3679**  
**October 15, 2004**